

REMARKS

Claims 22 and 36 are canceled without prejudice, and therefore claims 19, 21, 23, 30 to 32, and 35 are currently pending and being considered in the present application (since claims 24, 33, and 34 were previously withdrawn in response to a restriction requirement).

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for indicating that claims 22, 23 and 36 contain allowable subject matter. While the rejections may not be agreed with, to facilitate matters, the features of claim 22 have been included in claim 19, and claim 22 has been canceled without prejudice. Also, claim 23 now depends from claim 19. As to claim 35, the features of claim 36 have been included in claim 35, and claim 36 has been canceled without prejudice. Also, claim 35 has been rewritten so that it explicitly recites the features of the microstructured sensor of claim 19, rather than just reciting the microstructured sensor of claim 19. No new matter has been added, and support is provided by the present application. It is therefore respectfully submitted that claims 19, 21, 23, 30 to 32, and 35 are allowable. It is therefore respectfully requested that the objections be withdrawn.

Claim 32 was rejected under 35 U.S.C. § 112, ¶ 1 as assertedly failing to comply with the enablement requirement.

In this regard, the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention;

the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

It is respectfully submitted that the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation. The specification describes and explains how to practice the subject matter in each of the pending claims.

In this regard, as to claim 32, the “auxiliary structure” is described throughout the specification and illustrated in the figures. For example, “Figure 4a shows a top view of a chip system of a gas sensor ... having contact areas on two opposite sides and having *auxiliary structures for the cap processing at the edge of the chip.*” (See, specification, page 3, lines 4 to 7, (emphasis added)). Furthermore, “Figure 4 shows a top view of a chip system of a gas sensor ... having ... *auxiliary structures for cap processing on the edge of the chip.*” (Id., page 3, lines 12 to 16, (emphasis added)). The specification further provides that “*auxiliary structures 25 for the cap processing are formed before and after contact areas 20, 22 in longitudinal direction X, as parts of connecting area 3*; the same holds correspondingly in Figures 4a and 5. (Id., page 7, lines 18 to 22, (emphasis added)). In addition, the specification provides, with reference to Fig. 5, that “the *auxiliary structures 25* described in relation to Figures 3, 4a are formed as *parts of connecting area 3* for the cap processing in the isolation of the individual gas sensors 1.” (Id., page 8, lines 12 to 15, (emphasis added)). In view of the foregoing, is believed that the present application enables a person having ordinary skill in the relevant art to practice the claimed subject matter of the claims without undue experimentation.

The enablement rejection of claim 32 is therefore respectfully traversed.

Claims 19, 21, 25 to 27, 31 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,021,766 (the “Aine” reference).

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See

Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

While the rejections may not be agreed with, to facilitate matters, the features of claim 22 have been included in claim 19, and claim 22 has been canceled without prejudice. Also, claim 23 now depends from claim 19. As to claim 35, the features of claim 36 have been included in claim 35, and claim 36 has been canceled without prejudice. Also, claim 35 has been rewritten so that it explicitly recites the features of the microstructured sensor of claim 19, rather than just reciting the microstructured sensor of claim 19. No new matter has been added, and support is provided by the present application. It is therefore respectfully submitted that claims 19, 21, 23, 30 to 32, and 35 are allowable. It is therefore respectfully requested that the objections be withdrawn.

Claims 28 and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent no. 4,021,766 (the “Aine” reference).

Claims 19, 21, 25, 27, 31 and 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over Landsberger U.S. Published Patent Application No. 2006/0063292 or Lee et al., U.S. Patent No. 5,584,117.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some

articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, the features of claim 22 have been included in claim 19, and claim 22 has been canceled without prejudice. Also, claim 23 now depends from claim 19. As to claim 35, the features of claim 36 have been included in claim 35, and claim 36 has been canceled without prejudice. Also, claim 35 has been rewritten so that it explicitly recites the features of the microstructured sensor of claim 19, rather than just reciting the microstructured sensor of claim 19. No new matter has been added, and support is provided by the present application. It is therefore respectfully submitted that claims 19, 21, 23, 30 to 32, and 35 are allowable. It is therefore respectfully requested that the objections be withdrawn.

Accordingly, claims 19, 21, 23, 30 to 32, and 35 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending and considered claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Dated: 2/4/2009

Respectfully submitted,

By: 

Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200

Reg no.
33,865
Amar C
BESIRHAN

CUSTOMER NO. 26646